

Gueret I teaches a notched brush and make-up device including the brush. With reference to Figs. 1 and 9 of Gueret I, the Office Action alleges that Gueret I can be considered to teach many of the features recited in the pending claims. The Office Action concedes, however, that Gueret I fails to disclose a bristle-carrying portion forming an angle, particularly in the specific ranges recited in any of claims 1, 5-9. The Office Action relies on Anderson as allegedly making up for this shortfall in the application of Gueret I to the subject matter of the pending claims. The analysis of the Office Action fails for at least the following reasons.

Claim 1 recites, among other features, a brush fixed to said end portion of said rod, the brush including: a twisted-wire core fixed to said end portion of said rod, said core having a bristle-carrying portion and a remote end; and a plurality of bristles extending from the bristle-carrying portion of said twisted-wire core, said twisted-wire core being bent such that substantially all points of said bristle-carrying portion form an angle greater than 0° and less than 20° relative to said longitudinal axis of said end portion of said rod, and a receptacle adapted to receive said rod and said brush in an assembled condition, said receptacle having an inner wall and a wiper member, said rod and said brush being spaced from said inner wall in said assembled condition, said wiper member being disposed in said receptacle such that said wiper member wipes said brush as said brush is withdrawn from said receptacle.

The applied references are not combinable in the manner suggested by the Office Action for any reason, much less to have rendered obvious at least this combination of features positively recited in independent claim 1, for the reasons discussed below.

Anderson teaches a mascara applicator. Throughout its disclosure, Anderson specifically disparages prior art devices for the application of mascara that include "brushes with spirally wound or multiple tufts of random strips of bristles, 'wands, 'or cylindrical wands with threaded extremities and the like" as are disclosed in Gueret I. *See* col. 1, lines

19-33 (stating, in pertinent part, "[t]he prior-art applicators 10 tend not to separate the lash hairs but rather to deposit mascara crudely, causing the lashes to stick together in unattractive matted clumps."); *see also*, col. 3, lines 50-54 (describing the invention of Anderson as "markedly contrast[ing] with the tufts of multiple bristles characterizing many prior-art devices."); and col. 4, lines 11-14 (stating specifically "[i]t should be noted that the multiple rows [of the invention] are mounted so as not to produce a spiralling effect when the applicator is twirled. Spiralling tends to undo separation."). It is unreasonable that, given these explicit disclosures in Anderson disparaging the prior art, one of ordinary skill would have predictably combined any teaching from Anderson with a twisted-core bristled mascara brush, such as that disclosed in Gueret, for any reason, much less to address the shortfalls in the prior art that are addressed by the subject matter of the pending claims.

Further, the Office Action notes that Anderson teaches a mascara brush having a bend such that it forms an angle from about 0°-60°. Anderson indicates that the handle portion is angled with respect to the base "to provide convenience of handling and possible clearance away from [the] eyebrow." Col. 3, lines 42-44. The Office Action cites col. 4, lines 1 and 2 for the disclosed range of 0°-60°. In context, however, Anderson teaches "[h]andle portion 32 is integrally formed with base 28 and extends therefrom *at a substantial angle*, e.g., about 45°, although this angle *may be varied as desired*, e.g., from 0°-60°." Col. 3, line 71 - col. 4, line 2 (emphasis added).

The Office Action alleges that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the brush of Gueret by tilting the brush so it forms an angle with the longitudinal axis as taught by Anderson in order to provide spacing between the brush and handle portion to aid the user in applying a cosmetic. This conclusion is unreasonable based on the explicit disclosures in Anderson specifically disparaging the configurations of devices disclosed in Gueret 1. The Office Action alleges

that "[i]t further would have been obvious to one having ordinary skill in the art at the time the invention was made *to vary the angle as disclosed by Applicant*, since it has been held that where the general conditions of a claim are disclosed in the prior art (Anderson), discovering the optimum or workable ranges involves only routine skill in the art." OA at page 3-4 (emphasis added). In order to support this conclusion, the Office Action cites *In re Aller*, 105 USPQ 233. This citation to the 1955 CCPA decision in *Aller* side steps the 1977 CCPA decision in *In re Antonie*, 195 USPQ 6, which established that only "result-effective variables" would be obvious to optimize. Specifically, the *Antonie* court found that a particular parameter must *first* be recognized as a result-effective variable, *i.e.*, a variable which achieves a recognized result, *before* determination of the optimum or workable ranges of said variable might be recognized as routine experimentation. See MPEP §2144.05(II)(A) and (B). There is nothing on this record that meets the standard articulated in the MPEP, and which was relied upon by the Board of Patent Appeals and Interferences ("Board") in the precedential opinion of *Ex parte Whalen*, 89 USPQ2d 1078 (BPAI 2008). In *Whalen*, the Board reversed the Examiner's rejection of the pending claims based on a determination that "the Examiner [had] not pointed to any teaching in the cited references, or provided any explanation based on scientific reasoning, that would support the conclusion that those skilled in the art would have considered obvious to 'optimize' the prior art" in the manner asserted by the Office Action. *Ex parte Whalen* at 14. There was no showing in *Whalen* that the assertedly optimized variable was a "result-effective variable." The same is the case on the record in this application as well. There has been no showing throughout the examination of this application that the claimed angles are mere optimizations of a recognized result-effective variable, based on the teachings of Anderson, or otherwise.

The claimed configuration results in benefits that are unforeseen in the prior art of record. These benefits are described and discussed throughout Applicant's specification. The

Examiner's attention is further directed to paragraphs 6-13 of Applicant's Declaration Under 37 C.F.R. §1.132 dated February 2, 2009 (1) that discuss unexpected benefits achieved by the claimed configuration, and (2) that detail a portion of the experimentation by the inventor by which those benefits were realized.

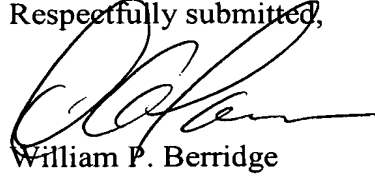
For at least the foregoing reasons, at least Gueret I and Anderson are not combinable in the manner suggested by the Office Action. Further, it has not been shown that an angle of a bristle-carrying portion relative to a longitudinal axis of an end portion of said rod is a result-effective variable, the optimization of which can be characterized as being achieved through routine experimentation. In this regard, the analysis of the Office Action is incomplete, and therefore fails. Based on the shortfalls in the conclusions of the Office Action, claim 1, and claim 36 reciting similar features, are patentable over the currently-applied references. Further, and because Gueret II does not make up for the above-identified shortfalls in the application of Gueret I and Anderson to the combination of features positively recited in independent claim 1, claims 3-32 and 35 are also patentable over the combinations of applied references, for at least the respective dependence of these claims on claim 1, as well as for the additional features these claims recite.

Accordingly, reconsideration and withdrawal of the rejections of claims 1, 3-32, 35 and 36 under 35 U.S.C. §103(a) over the asserted combinations of applied references are respectfully requested.

In view of the foregoing, it is respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-32, 35 and 36 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Petition for Extension of Time

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